

REMARKS

Favorable reconsideration of the subject application is respectfully requested in view of the above amendments and the following remarks. This is a Response to the Office Action dated March 2, 2004 and the Advisory Action dated October 25, 2004. Claims 2, 5-26 and 28-38 are canceled, therefore claims 1, 3 and 27 are pending. Claims 1, 3 and 27 have been amended to incorporate the subject matter of now canceled claim 2, and in accordance with the Examiner's suggestions conveyed in the Advisory Action dated October 25, 2004. Support for the amendments may be found throughout the specification and claims as originally filed. In particular, specification support may be found at line 6, page 9 regarding detection by providing a growth environment in a modified culture medium wherein the microorganisms are permitted to multiply to optimal levels. No new matter has been added to the application. It should be noted that the above amendments are not to be construed as acquiescence with regard to the Examiner's rejections and are made without prejudice to prosecution of any subject matter removed or modified by this amendment in a related divisional, continuation or continuation-in-part application.

Applicants submit the above amendments obviate the outstanding rejections set forth in the Office Action dated March 2, 2004, and maintained in the Advisory Action dated October 25, 2004.

Rejection Under 35 U.S.C §102(b)

Claims 1 and 27 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Deng *et al.* In particular, the Action asserts that Deng, *et al.* discloses culturing *Mycobacterium smegmatis* in glycol-alanine-salts medium in the presence of Tween 80 and ethambutol, a structure modifying compound and thus, teaches a general enrichment media comprising a structure modifying organic chemical, as presently claimed.

Applicants respectfully traverse this basis for rejection and submit the cited reference fails to anticipate the presently claimed invention for reasons provided herein and for reasons previously made of record. Applicants note that in order for a prior art reference to anticipate a claim, it must disclose each feature of the claimed invention. *Verdegaal Bros. v.*

Union Oil Co. of Calif., 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants submit the present invention is related to a composition for exposing antigenic epitopes of a microorganism, comprising a general enrichment media, a detergent, and at least one structure modifying organic chemical, wherein the structure modifying organic chemical is selected from the group consisting of 2,4-dinitrophenol and carbonyl cyanide-m-chlorophenyl hydrazone, as well as a method that utilizes the claimed composition for propagating a microorganism.

Applicants note the Office Action dated March 2, 2004 concedes Deng, *et al.*, fail to teach growing microorganisms in the presence of the structure modifying organic chemical 2,4-dinitrophenol or carbonyl cyanide-m-chlorophenyl hydrazone. Thus, the cited reference fails to disclose each and every feature of the presently claimed invention. As such, Applicants respectfully submit Deng, *et al.* does not anticipate the presently claimed invention. Applicants respectfully request this basis for rejection be reconsidered and withdrawn.

Rejection Under 35 U.S.C. §103(a)

Claims 1-4 and 27 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over Deng *et al.*, in view of Marino *et al.* and Ohyama *et al.* Specifically, the Action asserts that Deng *et al.* teach growing microorganisms in media comprising a detergent and a structure modifying compound, namely ethambutol, but concedes the cited reference fails to teach the specifically recited compounds of 2,4-dinitrophenol and carbonyl cyanide-m-chlorophenyl hydrazone. The Action further asserts Marino *et al.* and Ohyama *et al.* teach growing microorganisms in 2,4-dinitrophenol and carbonyl cyanide-m-chlorophenyl hydrazone, respectively. The Action concludes it would have been obvious to a person having ordinary skill in the art to combine the cited references and arrive at the presently claimed invention.

Applicants respectfully traverse this basis for rejection and maintain the Action fails to establish a *prima facie* case of obviousness. The Federal Circuit has held that a *prima facie* case of obviousness may only be satisfied by showing "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art *would lead* that individual to combine the relevant teachings of the references." (Emphasis original) *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Further, the Federal Circuit has stated that finding some teaching or motivation to combine the cited references is necessary in order to prevent the inadmissible use of hindsight based on the invention in order to defeat patentability, and "if identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 149 F.3d 1350, 57, 47 U.S.P.Q.2d 1460 (Fed. Cir. 1998). Applicants submit the Action fails to state how it is that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicants respectfully submit nothing in Deng *et al.*, Marino *et al.*, or Ohyama *et al.* provides a suggestion or motivation to one having ordinary skill in the art to combine these references in order to arrive at the presently claimed invention. Applicants note Deng *et al.* describe the inhibition of biosynthesis of a mycobacterial cell wall component; Marino *et al.* teach synthesis of an enzyme in intact *Salmonella typhimurium* requires proton motive force; and Ohyama, *et al.* disclose the ability of *E.coli* to adapt to changes in environmental osmolarity. Applicants maintain Deng *et al.*, Marino *et al.* and Ohyama *et al.* do not even remotely contemplate the presently claimed invention of a composition for exposing antigenic epitopes of a microorganism, comprising a general enrichment media, a detergent, and at least one structure modifying organic chemical, wherein the structure modifying organic chemical is selected from the group consisting of 2,4-dinitrophenol and carbonyl cyanide-m-chlorophenyl hydrazone, as well as a method that utilizes the claimed composition for propagating a microorganism. Therefore, Applicants respectfully request this basis for rejection be reconsidered and withdrawn.

In view of the above amendment and remarks, Applicants submit that all of the remaining claims are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited. A good faith effort has been made to place this application in condition for allowance. However, should any further issue require attention prior to allowance, the Examiner is requested to contact the undersigned at (206) 622-4900 to resolve the same.

Furthermore, the Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

Philip T. Feldsine, et al.

SEED Intellectual Property Law Group PLLC



William T. Christiansen, Ph.D.

Registration No. 44,614

Enclosure:

Postcard

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

536249_1.DOC